

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of: Rajinder Singh *et al.***Patent No.:** 7,517,886**Issued:** April 14, 2009**Application No.:** 10/631,029**Filed:** July 29, 2003**For:** METHODS OF TREATING OR
PREVENTING AUTOIMMUNE
DISEASES WITH 2,4-
PYRIMIDINEAMINE COMPOUNDS**Attorney Reference No.:** 7946-79649-01**FILED BY EFS
ON NOVEMBER 24, 2010**FILED BY ELECTRONIC FILING SYSTEM
UNITED STATES PATENT AND TRADEMARK OFFICE**REQUEST FOR RECONSIDERATION OF DECISION ON PETITION**

Rigel Pharmaceuticals, Inc. (Rigel) requests reconsideration of the Decision on Petition (Decision), dated September 24, 2010, concerning all patent and patent applications enumerated in the Petition, filed on April 29, 2010, requesting expungement of information contained in a Confirmation of Exclusive Patent License (Confirmation). The Confirmation was recorded on August 15, 2005, at Reel 016888, Frames 0112-0115. Copies of the Petition and the Decision are attached.

No fee should be required to file this Request for Reconsideration.

**I. No Ownership Right was Conveyed that Requires
Maintaining Assignment Record Integrity**

The Decision states that Rigel did not sufficiently explain how removing a document in its entirety would not affect the “assignment” records. An exclusive license is *not* an assignment; therefore, expunging a license agreement document cannot affect the integrity of the *assignment* record. According to the Manual of Patent Examining Procedure (MPEP), “...a license is not an assignment of the patent. Even if the license is an exclusive right, it is **not** an assignment of patent rights in the patent or application.” MPEP § 301. Because a license agreement is *not* an assignment, expunging the Confirmation would not affect the integrity of the U.S. Patent and Trademark Office’s (USPTO) “assignment records.”

II. Rigel is Requesting a Remedy that does Maintain the Integrity of the USPTO Records

The policy reason behind the Decision is that the USPTO wants to “maintain the integrity of the assignment records.” Rigel, the patent owner, seeks the same result. The information provided by the assignment records should allow third parties to track title to pending applications and issued patents. The license agreement between Rigel and Pfizer Inc. was not a license of the entire patent rights, did not convey an ownership interest in the pending applications and/or issued patents, and hence the USPTO records are currently incorrect. Since no agreement between Rigel and Pfizer assigns patent rights or otherwise affects title, the Confirmation should be expunged in order to correct, i.e. establish integrity of, the USPTO assignment database. By expunging the Confirmation, the USPTO would eliminate confusion as to the history of the claimed interests in the patent.

The question posed then is what does the term “integrity” mean in this context? Does it mean simply maintaining a record of every document recorded, regardless of the correctness of such document? This interpretation undermines the central policy of allowing third parties to determine property rights in pending applications and issued patents.

Alternatively, and more appropriately, the term “integrity” should mean maintaining *correct* records that allow third parties to determine title to pending applications and issued patents. This is a result desired by Rigel. The license agreement was correct, but the statement in the Notice of Recordation accompanying the Confirmation was incorrect. A corrective document therefore is not required, as the underlying license was correct.

A party reviewing the current USPTO records is being misled as to the property rights associated with the listed applications and patents. Accordingly, the integrity of the assignment records is compromised.

III. Rigel does not Seek an Extraordinary Remedy

The Decision also states that the petition sought an extraordinary remedy, and the USPTO will not resort to such remedy if the rules of practice and the procedures already provide an avenue for the requested relief. The relief sought by Rigel would not properly be addressed by the procedures set forth in MPEP § 323.01, and hence the rules of practice and procedure do not provide an adequate relief. MPEP § 323.01 concerns procedures for correcting “an error in a

recorded assignment document (or other document affecting "title")." MPEP § 323.01(b). However, an exclusive license is *not* an assignment, does not affect "title," and there was no error in the license agreement. This correction procedure, therefore, is not an appropriate remedy for correcting the information set forth in the Confirmation.

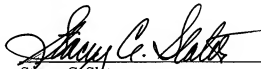
Rigel does not seek an extraordinary remedy, but rather seeks the same result required by the USPTO, i.e. integrity of the assignment records.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By



Stacey C. Slater
Registration No. 36,011

APR. 29. 2010 9:29AM

KLARQUIST 503595530

RECEIVED
CENTRAL FAX CENTER

NO. 1625 P. 1/5

QWG:mjc 04/29/10 1430813

APR 29 2010

Attorney Ref. No. 7946-79649-01
Application Number 10/911,684

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rajinder Singh

Application No. 10/911,684

Filed: August 3, 2004

Confirmation No. 9581

For: 5-FLUORO-4N-PHENYL-4-
PYRIMIDINEAMINE COMPOUNDS

Examiner: Sikarl A. Witherspoon

Art Unit: 1621

Attorney Reference No. 7946-79649-01

CERTIFICATE OF FACSIMILE

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being facsimile transmitted to fax number 571-273-8300 on the date shown below.

Attorney or Agent
for Applicant(s): /Gillian Gardner/

Date Transmitted April 29, 2010

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

COMMUNICATION REGARDING PETITION UNDER 37 C.F.R. § 1.59(b) TO
EXPUNGE ASSIGNMENT RECORDS (M.P.E.P. § 323.01(d), 8th Ed.)

We represent Rigel Pharmaceuticals, Inc. with respect to a Petition Under 37 C.F.R. § 1.59(b) to Expunge Assignment Records (Petition) that was signed by Gregg C. Benson, Assistant General Counsel of Pfizer Inc. The Petition was filed via facsimile on December 4, 2009, by Pfizer Inc. The Petition was filed on the advice of Ms. Kenya McLaughlin, with whom the undersigned spoke on November 10, 2009, regarding this matter.

The undersigned further spoke with Ms. Patricia Ball on March 25, 2010, who indicated that there was no record of the Petition and confirmed that it was not present in the image file wrappers of the applications listed in the Petition. Attached are copies of the Petition as signed by Mr. Benson and the facsimile transmission record indicating that the Petition was successfully transmitted.

The attached Petition requests expungement of assignment records with respect to the referenced application as listed on the Petition. Deduction of the required fees was authorized from Deposit Account No. 16-1445 in the Petition as signed by Mr. Benson. The required

Page 1 of 2

APR. 29. 2010 9:29AM

KLARQUIST 5035955301

NO. 1625 P. 2/5

GWG:mjc 04/29/10 1430813

Attorney Ref. No. 7946-79649-01
Application Number 10/911,684

fees should therefore be deducted from Deposit Account No. 16-1445, as authorized by Mr. Benson. But, Klarquist Sparkman, LLP also hereby authorizes deduction of any required fees from Deposit Account No. 02-4550.

Please telephone the undersigned if any additional information is required to grant this Petition and expunge the assignment records as requested.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Gillian Gardner/
Gillian Gardner
Registration No. 62,755

cc: Docketing

RECEIVED
CENTRAL FAX CENTER

APR 29 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF FACSIMILE

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being facsimile transmitted to facsimile number 571-273-8300 on the date shown below.

Attorney or Agent
For Applicant(s)

Date Transmitted

[Signature]
Reg. No. 76,357

December 04, 2009

PETITION UNDER 37 C.F.R. § 1.59(b) TO EXPUNGE ASSIGNMENT RECORDS
(M.P.E.P. § 323.01(d), 8th Ed.)

1. Rigel Pharmaceuticals, Inc. ("Rigel") is the Assignee of the applications listed below.
2. Gregg Benson is authorized to act on behalf of Pfizer Inc. ("Pfizer").
3. Pfizer hereby petitions under 37 C.F.R. § 1.59(b) to expunge the assignment records concerning the Confirmation of Exclusive Patent License ("Confirmation") that was recorded on August 15, 2005, at Reel 016888, Frames 0112-0115, against the following applications:
 - a) 10/355,543
 - b) 10/858,343
 - c) 10/911,684 ✓
 - d) PCT/US03/03022
 - e) 10/631,029
 - f) PCT/US2003/024087
 - g) PCT/US04/24716
 - h) 10/903,263
 - j) 60/590,789
4. The Confirmation concerned a Collaborative Research and License Agreement ("Agreement"), dated January 18, 2005, between Rigel and its licensee, Pfizer. The Confirmation unintentionally contained erroneous information, was unintentionally recorded in error against the listed patent applications, and both Rigel and Pfizer agree that the Confirmation was recorded unnecessarily and should be expunged.
5. The normal corrective procedures outlined in MPEP § 323.01(a) through § 323.01(e) would not provide Rigel and Pfizer adequate relief because 1) the errors in the recorded Confirmation are not mere typographical errors, and 2) the Confirmation was recorded in error against the listed patent applications.
6. Rigel and Pfizer assert the integrity of the assignment records would not be affected by granting this Petition because recording the Confirmation was unnecessary. Moreover,

Page 1 of 2

RECEIVED
CENTRAL FAX CENTER

APR 29 2010

failure to grant this Petition would result in maintaining erroneous property rights records for the listed patent applications.


7. Please address all future correspondence concerning this Petition to **Customer Number 74839**: Travis Young, Ph.D. at Rigel Pharmaceuticals, Inc., 1180 Veterans Blvd., South San Francisco, CA, 94080, telephone number (650) 624-1434.
8. Fee
- The fee required by 37 C.F.R. § 1.17(g) is submitted herewith by deposit authority:

- ☒ Charge Deposit Account No. 16-1445 the sum of \$200.00.
- ☒ The Director is hereby authorized to charge any additional fee(s) required to file this Petition, or credit over-payment, to Deposit Account No. 16-1445.

Respectfully submitted,

PFIZER INC.

By


Gregory C. Benson
Assistant General Counsel
Registration No. 30,997

Transmission Report

Date/Time 12-04-2009 04:17:48 p.m.
 Local ID 1 880 441 5221
 Local ID 2 880 441 5221

Transmit Header Text
 Local Name 1 PFIZER PATENT LEGAL-GROTON
 Local Name 2 PFIZER PATENT-LEGAL GROTON

This document : Confirmed
 (reduced sample and details below)

Document size : 8.5"x11"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL STOP PETITION
 COMMISSIONER FOR PATENTS
 P.O. BOX 1450
 ALEXANDRIA, VA 22315-1450

CERTIFICATE OF PRIORITY
 This document is the property of the United States Patent and Trademark Office. It is to be retained by the applicant or their agent. It is not to be reproduced, sold, or otherwise disposed of without the express written consent of the United States Patent and Trademark Office.

Signature of Agent
 Date Received 4/29/2010

PETITION UNDER 37 C.F.R. § 1.560 TO REEXAMINE ASSIGNMENT RECORDS

1. Rigel Pharmaceuticals, Inc. ("Rigel") is the Assignee of the applications listed below.
2. Gregg Deamus is authorized to act on behalf of Rigel, Inc. ("Rigel").
3. Pfizer hereby petitions under 37 C.F.R. § 1.560 to reexamine the assignment records concerning the Confirmation of Exclusive Patent License ("Confirmation") that was entered on August 12, 2005, in Rigel 016633, between 0112-0115, against the following applications:
 - a) 10/535,540
 - b) 10/538,143
 - c) 10/571,684
 - d) PCT/US2005/030823
 - e) 10/671,809
 - f) PCT/US2005/030407
 - g) PCT/US2004/01916
 - h) 10/603,003
 - i) 60/990,789
4. The Confirmation concerned a Collaborative Research and License Agreement ("Agreement"), dated January 18, 2005, between Rigel and its licensee, Pfizer. The Confirmation was entered by the United States Patent and Trademark Office, and was recorded in the United States Patent and Trademark Office, and both Rigel and Pfizer agree that the Confirmation was recorded erroneously and should be corrected.
5. The recordative procedure required in MPEP § 222.01(a) through § 222.01(d) would not provide Rigel and Pfizer adequate relief because (1) the error in the recorded Confirmation was not a clerical or typographical error, and (2) the Confirmation was recorded in error against the listed patent applications.
6. Rigel and Pfizer assert the integrity of the assignment records would not be affected by granting this Petition because re-entering the Confirmation was necessary. Moreover,

Page 1 of 1

Total Pages Scanned : 2

Total Pages Confirmed : 2

No.	Job	Remote Station	Start Time	Duration	Pages	Line	Mode	Job Type	Results
001	759	USPTO	04:10:57 p.m. 12-04-2009	00:00:24	2/2	1	EC	H8	CP28400

Abbreviations:

H8: Host send
 HR: Host receive
 WS: Waiting send

PL: Polled local
 PR: Polled remote
 MS: Mailbox save

MP: Mailbox print
 CP: Completed
 FA: Fail

TU: Terminated by user
 TS: Terminated by system
 RP: Report

G3: Group 3
 EC: Error Correct



UNITED STATES PATENT AND TRADEMARK OFFICE

746-222-01
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

McDonnell Boenken Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago IL 60606

MAILED

SEP 23 2010

OFFICE OF PETITIONS

In re Patent No. 7517,886 :
Issue Date: April 14, 2009 :
Application No. 10/631,029 : **DECISION ON PETITION**
Filed: July 29, 2003 :
Inventor: Rajinder Singh et al :

This is a decision on the petition for expungement of information, filed April 29, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 15, 2005 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

- (A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
- (B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Corrections may be made on the original assignment document, for example, by lining out an incorrect patent or application number in a merger or change of name (see MPEP §314). As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is not a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

In addition, only \$200.00 was paid due to the erroneous assumption that the petition was properly filed under 37 CFR 1.59. A petition under 37 CFR 1.59 applies to application files, not assignment records. Thus, a petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of \$400.00 is required. An additional \$200.00 has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.



David Bucci
Petitions Examiner
Office of Petitions

Cc: Gillian Gardner
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland Oregon 97204